

## **REMARKS**

Claims 1-20 are now pending in this application. Claims 1,7, 10,13, 18, and 20 are independent. Claim 1 has been amended merely as to formal matters in response to the Examiner's objection, and claims 18-20 have been added. No claims have been canceled. In view of the following remarks, consideration and allowance of claims 1-20 are respectfully requested.

### **Objection to Claim 1**

Withdrawal of the objection to claim 1 due to a typographical error is requested. Claim 1 has been amended in a manner that is believed to overcome the stated basis for objection.

### **Unpatentability Rejection over Wang et al.**

Withdrawal of the rejection of claims 1-5, 7-8, 10-11, 13-14, and 16-17 under 35 U.S.C. §103(a) as allegedly being unpatentable over Wang et al. ("Wang") (US 6,009,321) is requested.

### ***Specific Deficiencies of Wang with Respect to the Independent Claims***

#### **Independent Claim 1**

The applied art, Wang, either alone or in combination, does not disclose, teach, or suggest a method that includes, *inter alia*, "...receiving a trace command in said functional entity, the command identifying at least one subscriber whose signaling messages are to be traced and indicating a tracer to which information obtained during tracing is sent; ***starting tracing in the functional entity, wherein said tracing comprises sending to the tracer a copy of a signaling message related to the subscriber to be traced in response to receiving or transmitting the signaling message in the functional entity, wherein the copy of the signaling message sent to the tracer is identical to the signaling message of the subscriber,***" as recited in independent claim 1 as amended (*emphasis added*)..

### **Independent Claim 7**

Further, Wang, either alone or in combination, does not disclose, teach, or suggest a mobile communication system that includes, *inter alia*, "...operating means for giving instructions to the at least one network element, ***wherein the operating means are arranged to give a trace command to the network element***, the command identifying at least one subscriber whose signaling messages are to be traced and indicating a tracer to which information obtained during tracing is sent, ***the network element is arranged to be responsive to the trace command, and to send to the tracer a copy of a signaling message related to the subscriber in response to the network element receiving or transmitting the signaling message, wherein the copy of the signaling message sent to the tracer is identical to the signaling message related to the subscriber***," as recited in previously presented independent claim 7 (*emphasis added*).

### **Independent Claim 10**

Further, Wang, either alone or in combination, does not disclose, teach, or suggest a network element that includes, *inter alia*, "***reception means for receiving a trace command, which identifies at least one subscriber whose signaling messages are to be traced and indicates a tracer to which information obtained during tracing is sent***, separation means for separating the signaling messages related to the subscriber to be traced from other signaling messages in response to the network element receiving or transmitting the signaling message, and ***means for sending to the tracer copies of the signaling messages related to the subscriber to be traced, wherein a copy of the separated signaling message sent to the tracer is identical to the separated signaling message***," as recited in previously presented independent claim 10 (*emphasis added*).

### **Independent Claim 13**

Still further, Wang, either alone or in combination, does not disclose, teach, or suggest a network element that includes, *inter alia*, "***a unit configured to receive a trace command, which identifies at least one subscriber whose signaling messages are to be traced and indicates a tracer to which information obtained during tracing is sent***; and an application part configured to be responsive to the unit, to separate a signaling message related to the subscriber to be traced

from other signaling messages in response to receiving or sending the signaling message in the network element; ***and to send to the tracer a copy of the separated signaling message, wherein the copy of the signaling message sent to the tracer is identical to the signaling message of the subscriber,***" as recited in previously presented independent claim 13 (*emphasis added*).

Accordingly, withdrawal of the rejection and allowance of claims 1-5, 7-8, 10-11, 13-14, and 16-17 in this application are respectfully requested.

### ***General Discussion of the Deficiencies of Wang***

As admitted by the Examiner in the previous Office Action, Wang is deficient in several ways with respect to limitations variously found in each of the independent claims 1, 7, 10, and 13. The Examiner previously relied upon the now-withdrawn Kalmanek '662 reference to overcome the admitted deficiencies of Wang, but now, surprisingly, finds all the recited limitations in Wang. Applicants respectfully traverse the rejection.

As regards Wang, Applicants share the Examiner's previous view (on page 3 of the Office Action of May 5, 2007) according to which Wang fails to disclose receiving a trace command in said functional entity, the command identifying at least one subscriber whose signaling messages are to be traced and indicating a tracer to which information obtained during tracing is sent; starting tracing in the functional entity, wherein the tracing comprises sending to the tracer a copy of a signaling message related to the subscriber to be traced in response to receiving or transmitting the signaling message in the functional entity.

Wang discloses that, for every phone call attempting to terminate to a wireless telephone, an MSC in an originating network extracts information from the call set up signaling, and sends this extracted information to an HLR associated with the MSC. The HLR generates a log for the information, the log being stored or displayed.

Wang emphasizes that the log needs to be generated for every subscriber, and therefore there is no need in Wang to identify a subscriber. Further, Wang teaches that only some calls are traced and if the call is to be traced, the extracted information may be processed. Thus, a log is created also for calls that are not traced.

In other words, *no trace command is sent in Wang, since each MSC is configured to detect all call attempts, and for each call attempt, to extract certain parameters and send them to the HLR regardless of whether or not the call is to be traced.*

Further, *Wang teaches tracing call related information, not signaling messages.* Therefore any claimed feature relating to the trace command is clearly not disclosed in Wang. Further, Wang teaches that the information is extracted regardless whether or not the call is traced; the tracing decision is performed in Wang afterwards.

In addition, Wang teaches that, if the call is to be traced, a device retrieves the stored information; the HLR does not perform anything during tracing. In other words, by teaching that information is sent to the HLR, Wang teaches that no information is sent to a tracer. That clearly is contrary to what is claimed in each of the independent claims.

Further, Applicants share the Examiner's view that Wang, fails to disclose that the copy of the signaling message sent to the tracer is identical to the signaling message of the subscriber. However, in recognition of this deficiency of Wang, the Examiner asserts that one of ordinary skill in the art understands that extracted information is identical to the transmitted information. Applicants traverse this characterization of the applied art.

Although the extracted parameters transmitted to the HLR in Wang may be identical to the information transmitted between the calling party and the called party, information extracted from a signaling message clearly is not identical to the whole signaling message.

In this regard, Wang actually teaches contrary to the various recitations of sending a copy of a signaling message by teaching that there is no need to copy the signaling message, and that copying of only some parameters in the message is sufficient to trace a call. Based on the above,.

Accordingly, based on the above, each independent claim and, as a consequence, all dependent claims are patentable over the art cited. Therefore, withdrawal of the rejection and allowance of claims 1-5, 7-8, 10-11, 13-14, and 16-17 in this application are respectfully requested.

**Unpatentability Rejection over Wang in View of Clarke et al.**

Withdrawal of the rejection of claims 6, 9, 12 and 15 under 35 U.S.C. §103(a) as being unpatentable over Wang in view of Clarke et al. ("Clarke") (US 5793752) is requested. It appears that there is a typographical error in the rejection in that it appears to still invoke the now withdrawn Kalmanek '662 reference in combination with Wang in this rejection.

Even assuming, *arguendo*, that Clarke teaches that for which the Examiner asserts, which Applicants do not necessarily agree, Wang does not teach or suggest all the claimed limitations of independent claims 1, 7, 10, and 13 from which claims 6, 9, 12 and 15 variously depend, as discussed above,. Accordingly, the unpatentability rejection of claims 6, 9, 12 and 15 should also be withdrawn without recourse to the additional patentable features recited therein.

**New Claims**

Newly presented claims 18-20 have been drafted to avoid the cited art and to further define that which Applicants are entitled to claim. Support for these claims may be found throughout the originally-filed disclosure such that no new matter is involved.

Consideration and allowance of claims 18-20 are respectfully requested.

**Conclusion**

In view of the above remarks and legal arguments, Applicants submit that each of pending claims 1-20 in this application is in immediate condition for allowance. An early indication of the same would be appreciated.

In the event the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number indicated below.

For any fees that are due, including fees for excess claims, the Director is hereby authorized to charge any fees or credit any overpayment during the pendency of this application

EINAMO -- 09/762,922  
Client/Matter: 060258-0277084  
Response to Non-Final Office Action mailed October 8, 2008

to Deposit Account No. 03-3975, under Order No. 060258-0277084 from which the Undersigned Attorney is authorized to draw.

Due Date: January 8, 2009

Respectfully submitted,

**Electronic Signature:** \_\_\_\_/Larry J. Hume/\_\_\_\_

Larry J. Hume

Registration No.: 44,163

PILLSBURY WINTHROP SHAW PITTMAN LLP

P.O. Box 10500

McLean, VA 22102

(703) 770-7900 (switchboard)

(703) 770-7981 (direct)

(703) 770-7901 (fax)

e-mail: [Larry.Hume@pillsburylaw.com](mailto:Larry.Hume@pillsburylaw.com)

Attorney for Applicant